

SN. 09/615,243

ATTORNEY DOCKET NO. CANO:009

REMARKS

Claims 1-30 remain pending in this application for which applicant seeks reconsideration.

Amendment

A more descriptive title has been provided.

Claims 1-8, 10-13, 15, and 17-20 have been amended to improve their form and overcome the non-art rejections. Specifically, the preamble of claims 1-8 has been amended to include the language "computer-implemented" to overcome the § 101 rejection, even though applicant traverses this rejection. Further, claims 1, 8, and 15 have been amended to clarify that the "list" refers to the --displayed list--. In claims 3-6, 10-13, and 17-19, the language "according to" has been changed to --in the processing order indicated by-- to further clarify and to overcome the § 112 rejection.

No new matter has been introduced.

§ 101 Rejection

Claims 1-14 were rejected under 35 U.S.C. § 101 because the **method** is not tied to a computer implementation. Claims 1-7 have been amended to include the language "computer-implemented" to overcome this rejection. Applicant, however, submits that claims 8-14 are not method claims but product claims. Accordingly, applicant requests the examiner to withdraw this rejection.

While this rejection is believed to be moot, applicant nonetheless traverses this rejection because the § 101 rejection, as presently rejected by the examiner, is facially improper. Specifically, the rationale behind this rejection is that because the method claims do not recite a computer implementation, they are not within technological arts and are unpatentable for that reason. Applicant takes Official Notice that the examiner has failed to establish prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas, or otherwise does not produce a useful result. Note that MPEP § 2106 particularly states that a claim should be rejected under § 101 only when it is devoid of

SN. 09/615,243

ATTORNEY DOCKET NO. CANO:009

any limitation to a practical application in the technological arts. A claim meets § 101 requirement if the claimed invention as a whole produces a "useful, concrete, and tangible" result that has a practical application.

As to the examiner's argument that the claimed invention is not within the technological arts, the examiner has failed to explain how lacking a computer implementation causes the invention to fall outside "the technological arts." Applicant submits that the method claims are directed to the technical field of management documents. That is well within the technological arts, regardless whether a computer is used or not.

Applicant requests the examiner to provide a full detailed explanation of the § 101 rejection, if this rejection is maintained.

#### § 112 Rejection

Claims 3-6, 10-13, and 17-19 were rejected under 35 U.S.C. § 112, second paragraph, because the examiner deems that the term "according to" broadens the scope of the claims rather than narrowing it. That language has been changed to --in the processing order indicated by-- to overcome this rejection. Applicant, however, disagrees with the examiner's assessment that the language "according to" broadens the claims. The language "according to" refers to how their parent claims processed the processing order. The language as presently amended means the same.

#### Art Rejection

Claims 1-30 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Hutchings (USP 5,940,813) in view of Judge (program code found at <http://www.comp.nus.edu.sg/~xuedamin/programs/204/doc.txt>). Applicant traverses this rejection at least to the extent that Hutchings does not teach assigning identifiers to a plurality of selected files of documents, where the identifiers have respective priorities indicative of the processing order in which the files are to be processed.

Claims 1, 8, and 15 call for displaying a list having the records concerning the files of documents, assigning identifiers to a plurality of records selected from the records in the

SN. 09/615,243

ATTORNEY DOCKET NO. CANO:009

displayed list, and executing processing on the selected records to which the identifiers are assigned, in the processing order indicated by the respective priorities of the identifiers. The identifiers have respective priorities that indicate the processing order in which the files are to be processed. This enables a plurality of documents provided with identifiers having respective priorities to be collectively processed in the order of priority.

In rejecting independent claims 1, 8, and 15, the examiner believed that Hutchings discloses all of the claimed elements except for displaying the list or queue. The examiner relies on Judge for the proposition that displaying the queue would have been obvious. Applicant disagrees with the examiner assessment of Hutchings at least to the extent that Hutchings does not disclose or teach assigning identifiers to a plurality of records selected from the records in the displayed list. Accordingly, even if the combination were deemed properly combinable, the combination would not have taught the claimed invention.

Hutchings discloses a PFM system 12 for processing mortgage payments and other types of batch data via on-line. Hutchings' system 12 includes a transaction handler 31, a transaction mover 32, and a transaction router 33. The handler 31 determines when data is available for processing within the PFM system 12. The handler 31 selectively starts the transaction mover 32 and assigns transactions to specific transaction routers 33 and the transaction mover 32 transfers data from temporary queue files to a transaction queue file. See column 6, lines 13-21. The transaction handler 31 in the PFM system is an asynchronous unit for controlling the mover 32 and the routers 33, and maintains a temporary storage queue within a handler mover control interface file 52. See column 6, lines 61-65. The handler 31 activates the mover 32 at intervals specified by the temporary storage queue stored in the handler mover control interface file 52. After the mover 32 is activated, the mover reads the mover queue records. The mover queue records contain information for determining, inter alia, the order in which the temporary queue files will be processed. The mover 32 internally sorts these files in a table based on priority codes, with the files having lower priority code numbers being processed before the files with the higher priority code number. See column 9, lines 13-23.

In short, Hutchings merely discloses internally sorting the temporary queue files in the table based on the priority codes, but simply does not disclose or teach assigning identifiers to a

SN. 09/615,243

ATTORNEY DOCKET No. CANO:009

plurality of records selected from the records in the displayed list. Note that claims 1, 8, and 15 call for the identifiers to have respective priorities that indicate the processing order in which the files are to be processed. Hutchings has no such a feature. Judge merely discloses displaying the contents of queue, and fails to alleviate the shortcomings of Hutchings. Accordingly, even if the combination were deemed proper, the combination would not have taught the invention set forth in claims 1, 8, and 15.

Conclusion

Applicant submits that claims 1-30 patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP



Marc A. Rossi  
Reg. No. 31,923

P.O. BOX 826  
Ashburn, VA 20146-0826  
703-726-6020 (Phone)  
703-726-6024 (fax)

05/09/05  
Date